

## **COMMENTS**

In the communication dated April 1, 2004, the Examiner requested that the Applicant describe how the claims are novel over the prior art. The Applicant appreciates the opportunity to assist the Examiner by pointing out the novelty of the pending claims. To assist this request, the Applicant provides a version of the claims that highlight the changes made from the previously canceled claims.

To the Applicant's knowledge, there is no single piece of prior art which anticipates the pending claims and during prosecution of this case, there have been no anticipation rejections. To the Applicant, there is no doubt that the claims are not anticipated. The only possible question is whether the claims are obvious. In previous office actions, the following pieces of art have been used as support for an obviousness rejection under section 103.

### **SYNOPSIS OF PRIOR ART**

Itkis (U.S. Patent no. 4,856,787) apparently discloses a distributed game network with a master game device and a number of slave game devices. The slave game device apparently is capable of playing concurrently a number of games such as poker, bingo, blackjack and keno. The slave game device apparently receives commands from the master game device and sends the local game status and accounting information to the master game device. The slave device apparently has a touch screen and also discloses that a light pen may be used to select items. When a keno number is selected, the reference apparently discloses that the number is displayed as crosshatched.

Saikawa (U.S. Patent no. 6,509,896) apparently discloses an image processing unit for a shooting game in which suitable images can be displayed according to a given situation, and in which more exciting and easy-to-manipulate images are displayed. Coordinate values for objects in three-dimensional virtual space are established on the basis of prerecorded object shape data. Apparently, a gun can be used to play the games and the gun as air-

powered recoil. An object of the Saiwaka invention apparently is to provide an image processing unit displaying images that are more playable and more exciting.

Martin (U.S. Patent no. 5,618,232) apparently discloses an electronic game device system that is switchable between an amusement mode and a gaming or gambling mode where the switch may be automatic depending on the geographical location of the system. Martin also apparently discloses an improved method of operating a touch screen on a CRT or LCD computer screen which uses finger release as input registering, and also may use highlighting of a button area when pointed to by a user for any highlighted button.

### **ARGUMENT**

When one looks to the proposed combination of Itkis, Saikawa and Martin as put forth in previous office actions, such a combination is improper in that there is no motivation to combine the references as indicated by the different problems that each reference is addressing. Itkis addresses the problem of playing traditional casino games where players can play against each other by using slave machines that are in communication with a master game machine. There is no mention of playing games beyond the traditional casino games.

Saikawa is concerned with developing an improved manner to manipulate, track and shoot at images in a virtual three-dimensional space in an action game. Saikawa also is concerned with adding further realism to action games such as baseball or shooting games by adding feedback to the pointing device. Saikawa is also interested in making the game more challenging by using an improved method or tracking and displaying images to make it more challenging to shoot at the moving or obscured images.

Martin is concerned with creating a game that can be switched between a gambling game and an amusement game in order to not break any laws (possibly depending on the location of the game) and providing an improved touch screen.

Of the three references, Itkis and Martin are concerned with traditional casino based games. Saikawa is concerned with tracing and selecting moving images such as a baseball or a monster and selecting (or shooting at) such moving images necessitates a different type of pointer. As the references are addressing different problems, there is no motivation to combine them as required by MPEP, Section 2145.X.C.

In Saikawa, using a traditional touch screen (or light pen) to track and select moving images would not be nearly as effective or fun. In addition, the goal of tracing a moving image is more challenging and stimulating when using a known object such as a gun or a remote control. The additional requirement of "good aim" adds another element to the game because in such games, an individual not only has to select the proper image on the display, the user has to properly aim at the image which often times is moving or purposely obscured.

Further, in a casino based game such as Itkis or Martin, the casinos want a player to make a selection. The images that can be selected are stationary and often are located in prominent locations to make selection easier. As the images to be selected are intentionally stationary and clearly visible, it make sense to use a traditional touch screen as there is little or no challenge involved in making a selection in a traditional casino game. In addition, the casinos want players to make a selection so it would be illogical in Itkis or Martin to look to add to Saikawa the element of attempting to select/shoot a moving image. As a result, the motivation found in the reference is to not combine the references.

#### INVENTOR AT THE WORKBENCH

In examining obviousness issues, some courts have used the hypothetical situation of an inventor sitting at his/her work bench surrounded by the prior art. The question is whether it would have been obvious to the inventor to combine some pieces of the prior art. The Applicant argues that the inventor in this case would not have reached for the Saikawa reference because Saikawa is directed to a game where there intentionally is a challenge in

selecting objects. Casino type games attempt to make it easy to select items on the display unit, not a challenge, so that a player can play more games in a shorter period of time.

Further, Saikawa adds extra steps to a game that would further teach away from its inclusion. In most gaming units, a player can use a touch screen or a simple push-button type switch to select an item. This is by design as casinos want to make it easy for a player to make a selection such that the player can play more games in a certain amount of time. Adding Saiwaka would add the additional steps of having to reach for the virtual object, aim the virtual object, then select an item on the display using the virtual object. Accordingly, the inventor at his/her work bench would not have the motivation to add Saikawa due to the added steps.

Accordingly, there is no suggestion as required by MPEP 2145.X.C to combine a traditional casino game like Itkis or Martin with a pointing device from an action game like Saikawa. See, In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (reciting the need for findings regarding the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or other factual findings to support an obviousness analysis).

Further such a combination would be contrary to accepted wisdom. Casinos want games to proceed quickly such that more money will flow through the games. Adding Saiwaka would add more steps which would slow gameplay which is contrary to accepted wisdom, meaning that the combination is improper according to MPEP 2145.X.D.3.

A third reason that the pending application is not obvious in view of Itkis, Saikawa and Martin is that all the independent claims as amended call for the virtual object to provide feedback to the user. Providing feedback is found in Saikawa which makes sense as it is an action game. However, Itkis and Martin are traditional casino games and it does not make sense to add feedback to a non-action game as described in Itkis or Martin. In a traditional

casino game, there is little challenge to selecting an image as the images are stationary and prominent so it would not make sense to add feedback to successfully selecting a stationary image. Certainly, there is no teaching or motivation in Itkis or Martin to make this combination. The input device itself is an afterthought to the teachings of Itkis and Martin and providing feedback is beyond their teachings or suggestions, meaning there is no motivation to make such a combination.

Finally, the prior art does not suggest the desirability of such a combination of Itkis, Martin & Saiwaka as required by MPEP 2143.01. The ordinary skill in the art holds that games need to be simple to attract a wide variety of players. If the goal is make casino games more attractive, adding additional steps and complexity is in contrast to the desire to make games more attractive to players and goes against the ordinary skill in the art. Thus, such a combination is improper.

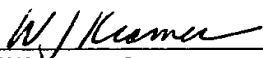
### CONCLUSION

In conclusion, the Applicant submits that all pending claims are novel and non-obvious and are in condition for allowance. In the light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, the Examiner is respectfully invited to telephone the undersigned.

Respectfully submitted,

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April 27, 2004